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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/469,561	12/22/1999	MARTIN PAGEL	045923-P016U	5104
29053	7590	07/14/2005	EXAMINER	
<b>DALLAS OFFICE OF FULBRIGHT &amp; JAWORSKI L.L.P.</b> <b>2200 ROSS AVENUE</b> <b>SUITE 2800</b> <b>DALLAS, TX 75201-2784</b>				WOO, RICHARD SUKYOON
		ART UNIT		PAPER NUMBER
				3639

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/469,561	PAGEL
	Examiner	Art Unit
	Richard Woo	3639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 April 2005.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-19, 21-28, 30-34 and 36-46 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-19, 21-24, 31-34, and 36-46 is/are rejected.  
 7) Claim(s) 25-28, 30 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Response to Arguments***

- 1) Applicant's amendments filed on April 11, 2005 has been entered.
- 2) Applicant's arguments, filed April 11, 2005, with respect to rejections under 35 U.S.C. sec ~~102~~<sup>112</sup>, 2<sup>nd</sup> paragraph have been fully considered and are persuasive. The rejection of Claims 2-11, 18, 23-28, 30-32, 36 and 46 has been withdrawn.
- 3) Applicant's arguments, with respect to rejections under 35 U.S.C. 101 and 102 have been fully considered but they are not persuasive.

In response to Applicant's argument that the examiner has not provided a prima facie showing that the invention of Claim 1 is not statutory under 35 U.S.C. 101, the examiner respectfully traverse this. Applicant has failed to establish that the **driver** in Claim 1 is statutory subject matter as required under 35 U.S.C. 101 (process, machine, manufacture, or composition of matter). Is the driver, or software, the process, machine, manufacture or composition of matter? Accordingly, the applicant's driver is software *per se* and is non-statutory unless the specifications of the applicant takes a special definition different from the norm or industry standard and requires **structure or hardware** as part of the "driver".

Although the applicant amended Claim 33 to include "embodied on a computer readable medium", the computer readable medium itself cannot be directed to a practical application of the invention in the useful art to accomplish a concrete, useful, and tangible result. When the computer readable medium is actually executed by the computer, the claimed subject matter produces a useful, concrete and tangible result.

In response to the applicant's argument that Dietrich et al. does not disclose a printer driver as set forth in the claim, Dietrich et al. discloses a hardware "read-write module" that MUST include the software to print the information on the envelope. Both the applicant's invention and Dietrich et al. utilize the computer to execute the particular software to carry out the printing function. Furthermore, in response to the applicant's argument that Dietrich et al. does not print the information from the database, the examiner invites the applicant's attention to Figure, in which the postage meter device prints the indicia and the address printing device also prints the address on the envelope.

Dietrich et al. discloses the invention that sends a data stream to a printing device (see the read/write device in communication with the printer) and creates a separate data stream (see the separate communication between the address printer and read/write device) for controlling additional functions (printing the address).

4) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 101***

5) 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6) Claims 1-19, 21-22, 33-34, and 36-46 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In Claim 1, the invention is directed to a “driver” and this is directed to software *per se* and is non-statutory unless the specifications of the applicant takes a special definition different from the norm or industry standard and requires structure or hardware as part of the “driver”. See Supra Response to Arguments.

In Claim 33, the computer readable medium itself cannot be directed to a practical application of the invention in the useful art to accomplish a concrete, useful, and tangible result. When the computer readable medium is actually executed by the computer, the claimed subject matter produces a useful, concrete and tangible result.

***Claim Rejections - 35 USC § 102***

7) Claims 1-4, 7-8, 12-13, 16, 23-24, 31-34, and 37-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Dietrich et al. (US 5,401,943).

As for Claim 1, Dietrich et al. discloses a printer driver comprising:  
means for abstracting at least a portion of a data stream (see Figure; abstract and col. 1, lines 39-56);  
means for using the abstracted data for controlling the function of printing of postage indicia (see col. 1, lines 46-52, 58-60); and  
means for creating data for controlling the printing of the postage indicia (see *Id.*).

As for Claim 2, Dietrich et al. further discloses the driver wherein the printing of address information on material is separate from the printing information in accordance with the data stream (see Figure for separate printings);

As for Claim 3, Dietrich et al. further discloses the driver wherein the printing of postage indicia is separate from printing (see Figure for two separate printers);

As for Claim 4, Dietrich et al. further discloses the driver wherein function includes a dialog box for allowing options from a user (any personal computer inherently must have the user input interface);

As for Claim 7, Dietrich et al. further discloses the driver wherein the function includes storing data a memory (every computer device must have the memory);

As for Claim 8, Dietrich et al. further discloses the driver wherein the abstracted portion is directed to a viewable medium (e.g. monitor);

As for Claim 12, Dietrich et al. further discloses the driver wherein the printer driver is operable on the data stream coming from a program operating in a computing device to control at least a portion of the printing of the printer (see Figure for the information carrier and read/write device that are linked to control the postage meter device and address printing device);

As for Claim 13, Dietrich et al. further discloses the driver wherein the printer driver is located remote from the personal computer (see Figure); and

As for Claim 16, Dietrich et al. further discloses the driver wherein the data patterns are selected from the list including: return address, destination address, beginning and ending of postage indicia data, beginning and ending of address information, beginning

and ending of document and the number of pages of the document (see Supra columns).

As for Claim 23, Dietrich et al. discloses a method comprising the steps of: sending a data stream to a printer (see Figure); reviewing the data stream to create a separate data stream (see the separate links between the postage meter device and address printing device); maintaining in a secure memory an amount available for controlling a generation of a postage indicia (see Figure; abstract; and col. 1, lines 39-56); calculating an amount of postage (for a particular printing) under joint control of the secure memory and the separate date stream (see col. 1, lines 46-52, 58-60); and deducting the calculated postage amount from the secure memory when the calculated postage amount is available in the secure memory (see Supra columns).

As for Claim 24, Dietrich et al. further discloses the method, wherein at least one function includes printing address information or printing postage information; As for Claim 31, Dietrich et al. further discloses the method, wherein the reviewing step includes the step of enabling a dialog box (see Supra Claim 4); As for Claim 32, Dietrich et al. further discloses the method, wherein the dialog box interacts with a user to provide return address and logo (col. 3, lines 1-15);

As for Claim 33, Dietrich et al. discloses a computer readable medium, when executed by a computer processor, including:

an abstracting program operable for reviewing the data stream to obtain information for controlling printing operations (such as printing postage indicia); and a controller working in cooperation with the abstracting program and with the information for controlling the printing of a postage indicia on material (see Figure and Supra columns for calculating the postage value based on the address information).

As for Claim 34, Dietrich et al. further discloses the medium including the operation printing of address information on material separate from material (see Figure for the separate address printing device);

As for Claim 37, Dietrich et al. further discloses the medium wherein the computer medium is operable on the data stream coming from a general personal computer (see Figure);

As for Claim 38, Dietrich et al. further discloses the medium, wherein the medium is located remote from the computer (see Figure for the IC, R/W device); and

#### ***Allowable Subject Matter***

9) Claims 5-6, 9-11, 14-15, 17-19, 21-22, 25-28, 30, 36 and 39-46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

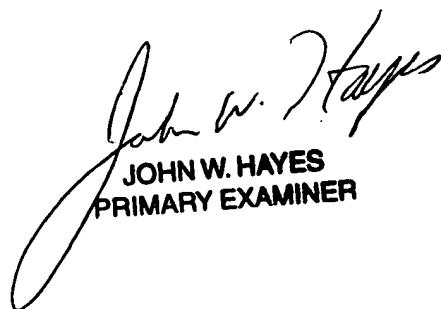
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 571-272-6813. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard Woo  
Art Unit 3639  
July 8, 2005



JOHN W. HAYES  
PRIMARY EXAMINER